

Appl. No. 10/632,258
Amdt. dated March 27, 2006
Reply to Office Action of December 29, 2005

REMARKS/ARGUMENTS

Claims 1 - 33 are presented for Examiner Huynh's consideration.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the foregoing amendments and the following remarks is respectfully requested.

1. Rejection of Claims 19 and 33 under 35 U.S.C. § 112, second paragraph. By way of the Office Action mailed May 18, 2005, the Examiner, rejected claims 19 and 33 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. We respectfully disagree.

First, it is unclear whether the Examiner has in fact rejected claim 19. While the Examiner rejects claim 19 under 35 U.S.C. § 112, second paragraph, in an opening statement (see page 4 of 29 December 2005 Office Action), there is no mention of claim 19 in the analysis that follows—only claim 33 is mentioned.

Second, if in fact Examiner has rejected claims 19 and 33 as outlined above, Applicants submit that the Examiner's rejection is improper. The Examiner appears to have misconstrued the import of an Applicant's election of a species for prosecution purposes. He appears to believe that election of a species eliminates, from the disclosure at the time of filing, any and all description directed to non-elected matter. This is not the case. There plainly is support in the written description, as filed, for the element "wherein said decorative graphic [i.e., the decorative graphic on said second face] is related to the theme of article graphics of a disposable article." For example, Figures 3 and 9, taken together, disclose a theme related to space. To the extent the Examiner is now arguing that Applicants' election of a species does not include claims 19 and 33, Examiner should have stated as such. Therefore, Applicants respectfully request that the Examiner withdraw his rejection of claims 19 and 33 under 35 U.S.C. § 112. Note: Applicants believe Examiner's objection to Figure 5 is similarly misplaced. I.e., Examiner appears to believe that the election of a species for prosecution purposes has literally carved out, from the disclosure, any description directed to non-elected matter. Again, if the Examiner is now saying that claims 19 and 33 are not covered by Applicants' election of a species, he should have stated this.

2. Rejection Under 35 U.S.C. § 102

Frankel does not disclose each and every element of the claimed invention.

Frankel is directed to a bath mat having temperature related indicia imprinted on a top side surface. See Abstract. Claim 33 of the present invention is directed to a disposable mat including,

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inter alia, "[a]t least one decorative graphic located on said second face, wherein said at least one decorative graphic has a decorative graphic theme and wherein said decorative graphic theme is related to the theme of article graphics of a disposable absorbent article."

Applicants assert that the bath mat of Frankel fails to disclose a mat including decorative graphics having a decorative graphic theme where the decorative graphic theme is related to the theme of article graphics of a disposable absorbent article. On pages 4 and 5 of the Office Action dated December 29, 2005, the Examiner asserts that the bath mat disclosed in Frankel "has a theme which is the head of an elephant...and wherein the theme is related to the theme of the article graphics...which are bubbles coming out of the elephants head." Applicants disagree. Initially, Applicants assert that bubbles are not thematically related to an elephants head. While the bubbles may be coming out of the Elephant's trunk, they are not related via a common theme with the picture of the elephants head. Moreover, claim 33 sets forth that the article graphics are "of a disposable absorbent article." Frankel does not disclose the bath mat having graphics that have a decorative graphic theme related to the graphics on a separate item, let alone the article graphics of a disposable absorbent article, such as a child's training pant, as described on Page 15, lines 16-29 of the specification. Accordingly, for at least these reasons, Applicants submit that claim 33 is patentable over Frankel.

3. Rejection of Claims 1-4, 8, 11-17, 31 and 32 Over Tsuneki (JP 2002-165729) in view of Mason III (5379558) Under 35 U.S.C. § 103.

The Examiner has not identified any suggestion, teaching, or motivation to combine the cited references.¹ And an evaluation of the cited references shows that there is no such suggestion, teaching, or motivation. Mason III appears to disclose, e.g., a "very dense, multi-directional needled batting of synthetic fibers" that are "saturated in a resin" that also contains "ultraviolet inhibitors, a selected colorant, and a fire-retardant." (See col. 4, lines 47-52.) The resulting mat, so treated, is protected from "deterioration due to sunlight and exposure from the environment for many years of use." (See col. 4, lines 61-63). That such mats are required to withstand many years of exposure to outside elements is evident from the disclosed use of the mat with "fire hydrants, pedestals for containing telephone equipment and electrical circuitry, gas vents, utility poles, guy wires, and the like." (See col. 3, lines 44-49.) Such explicit examples of uses are consistent with the disclosed mat being used generally "in conjunction with ground anchored structures that extend upwardly from an outdoor ground surface." (See col. 3, lines 44-46.) These

¹ *In re Dembiczak*, No. 98-1498 (Fed. Cir. Dec. 28 April 1999). The Court of Appeals for the Federal Circuit reversed obviousness rejections by the Board of Patent Appeals and Interferences because the Board failed to identify any suggestion, teaching, or motivation to combine prior art references asserted against the applicant's claims. Slip op. at 8.

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very dense, resin-impregnated mats, designed for many years of outdoor use, may be cut—e.g., with “a sharp blade”—when used with an outdoor, ground-anchored structured. (See generally Abstract; see also, e.g., col. 5, lines 30-40.)


The Examiner has not pointed to a teaching, motivation, or suggestion, within the four corners of a document on very-dense, resin-impregnated mats, designed for many years of outdoor use, and which may be cut, with a sharp knife, when used in conjunction with outdoor, ground-anchored structures (Mason III), that would lead a person of ordinary skill to combine its teachings with what appear to be images of articles used on floors around bathroom fixtures (Tsuneki). Similarly, the Examiner has not pointed to a teaching, motivation, or suggestion, within the four corners of a document depicting what appear to be images of articles used on floors around bathroom fixtures (Tsunek), that would lead a person of ordinary skill to combine its teachings with a document on very-dense, resin-impregnated mats, designed for many years of outdoor use, and which may be cut, with a sharp knife, when used in conjunction with outdoor, ground-anchored structures (Mason III). Nor can the Examiner find such teaching, motivation, or suggestion. Accordingly we respectfully request that the Examiner withdraw his obviousness rejection based on this combination of references.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

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Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I, Mary L. Roberts, hereby certify that on March 27, 2006 this document is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300.


Mary L. Roberts